

Applicant notes with appreciation that the Patent Office has withdrawn the objection of Claim 3, 6 and 7 under 35 U.S.C. §112, second paragraph.

By the present response, Applicant submits that the remarks and arguments below overcome the rejections by the Patent Office and places the application in condition for allowance.

The Patent Office alleges that *Iliff* teaches a method for matching medical condition information with a medical resource. The Patent Office alleges that *Iliff* teaches a method having the steps of:

providing a computer network having a plurality of remote computers and at least one remote server wherein the remote server hosts a website; accessing the website via an individual remote computer on the computer network; providing a database on the remote server wherein the database stores information relating to a plurality of medical conditions; and searching the database from the information wherein the search or request is based on the query or search request input into the database and further wherein the search discloses a medical resource that treats the medical condition queried.

However, the Patent Office admits that *Iliff* fails to explicitly disclose inputting a query into the website wherein the query relates to a medical condition. The Patent Office alleges that *Schlueter et al.* teach inputting a query or request for data into the website wherein the query relates to a medical condition. The Patent Offices further states:

It would have been obvious to one of ordinary

skilled in the art at the time the invention was made to modify the method for matching medical condition information with a medical resource of *Iliff* to include inputting of a query into the website wherein the query relates to a medical condition, as taught by Schlueter with the motivation of more quickly providing accurate records with simple and versatile input and output of information from a centralized data base, thereby hastening the treatment of disease.

Claim 1 requires a method for matching medical condition information with a medical resource. The method requires the step of searching the database for information wherein the search is based on the query input into the database and further wherein the search discloses a medical resource that treats the medical condition queried.

Claim 15 requires a system for matching medical condition information with a medical resource. The system requires a means for querying the database wherein the query relates to one of the medical conditions and a means for searching the database for information wherein the information discloses a medical resource that treats the medical condition queried.

Contrary to the assertions made by the Patent Office, *Iliff* merely discloses a medical advice system which determines if a serious medical condition exists and advises the patient to seek immediate medical attention if a serious medical condition exists. (See *Iliff*, column 36, lines 9-13.) The system performs a patient diagnosis, recommends the appropriate tests and provides a treatment table to obtain current treatment information for a

particular disease or diagnosis. (See *Iliff*, column 75, lines 18-26.) Moreover, *Iliff* discloses that "if a diagnosis was reached by the script, process 2500 proceeds to state 2546 to provide the diagnosis or medical advice to the user." (See *Iliff*, Fig. 30, column 79, lines 7-9.) Furthermore, *Iliff* discloses "every person can have access to high quality, 100%-consistent and affordable medical advice and information." (See *Iliff*, column 64, lines 51-53.)

Nowhere does *Iliff* teach or suggest searching a database for information wherein the search is based on a query input into the database and further wherein the search discloses a medical resource that treats the medical condition queried as required by Claims 1 and 15. Further, *Iliff* does not disclose inputting a query into the website wherein the query relates to a medical condition as required by Claim 1. Moreover, *Iliff* does not teach or suggest a system which requires a means for querying the database wherein the query relates to one of the medical conditions as required by Claim 15.

Schlueter et al. merely teach a method and a system that assists medical practitioners who treat or prescribe treatment of patients having a medical condition which requires long-term profiling of medical data taken from the patient's body. Additionally, *Schlueter et al.* disclose a method and a system wherein "its primary purpose is to receive medical readings over long periods of time, store the information as medical histories in

a data base application, and present the information to medical practitioners in a form which facilitates accurate diagnosis and treatment of patients' chronic medical conditions." (See *Schlueter et al.*, column 5, lines 47-52.) Further, *Schlueter et al.* disclose that "the received, or raw, data consists of individual readings or measurements of medically-important variables of patients" wherein "one patient might be measuring heart rate and blood pressure, another body weight or body fat, and a third blood sugar." (See *Schlueter et al.*, column 5, lines 53-58.) Moreover, *Schlueter et al.* disclose a system which "enables medical practitioners to quickly and easily spot trends and track the progress of patients they are treating without requiring excessive "extra steps" on the part of medical practitioners employing this invention." (See *Schlueter et al.*, column 7, lines 4-8.)

However, *Schlueter et al.* do not teach or suggest a method or system for matching medical condition information with a medical resource as required by Claims 1 and 15. Additionally, *Schlueter et al.* do not teach or suggest a computer network having a plurality of remote computers and at least one remote server wherein the remote server hosts a website as required by Claims 1 and 15. Further, *Schlueter et al.* do not teach or suggest inputting a query into the website wherein the query relates to a medical condition as required by Claims 1 and 15. Moreover, *Schlueter et al.* do not teach a search of a database for information wherein the search is based on the query input into the database and further wherein the

search discloses a medical resource that treats the medical condition queried as required by Claims 1 and 15.

Applicant asserts that neither *Iliff* nor *Schlueter et al.*, taken singly or in combination, disclose, teach, or suggest searching a database for information wherein the search is based on a query input into the database and further wherein the search discloses a medical resource that treats the medical condition queried as required by Claims 1 and 15.

Furthermore, *Iliff* and *Schlueter et al.* actually teach away from a search based on the query which discloses a medical resource that treats the medical condition queried as specifically defined in Claims 1 and 15 of the present invention. Moreover, *Iliff* merely teaches a system and a method which recommends the appropriate tests and provides a treatment table to obtain current treatment information for a particular disease or diagnosis. Additionally, *Schlueter et al.* merely teaches a system and a method which enables medical practitioners to quickly and easily spot trends and track the progress of patients. Further, *Schlueter et al.* merely teach a system and a method which receives raw data consisting of individual readings or measurements of medically-important variables of patients, stores the data, processes the data and presents the data to medical practitioners. Moreover, the querying and searching as specifically defined in Claims 1 and 15 require a query which relates to a medical condition and a search based on the query which discloses a medical resource that treats

the medical condition queried. Therefore, the querying and searching of both *Iliff* and *Schlueter et al.* teach away from the querying and searching of the present invention.

Moreover, with respect to the rejection of Claims 1-11 and 13-20 under 35 U.S.C. §103(a), one of ordinary skill in the art would never have been motivated to modify *Iliff* with *Schlueter et al.* in the manner suggested by the Patent Office in formulating the rejection of the claims under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the art would suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning

Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Iliff* and *Schlueter et al.* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have combined *Iliff* with *Schlueter et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103(a).

The Patent Office alleges that one skilled in the art would recognize that the method of *Iliff* for electronically reviewing and adjudicating medical insurance claims could be modified in light of *Schlueter et al.* to create a method and system for matching medical conditions information with a medical resource on a computer network. Applicant submits that the Patent Office is merely "piece-mealing" references together providing various teachings and positively defined limitations of Applicant's method and system to deprecate the claimed invention. Of course, hindsight reconstruction of Applicant's invention is impermissible.

The court in *In re McLaughlin* stated "[T]here is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of

ordinary skill in the art." *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

Applicant respectfully submits that the claims distinctly define the present invention from *Iliff* and *Schlueter et al.*, taken singly or in combination. Applicant respectfully submits that, for the reasons provided above, the rejection of Claims 1-11 and 13-20 under 35 U.S.C. §103(a) are improper and should be withdrawn. Notice to that effect is requested.

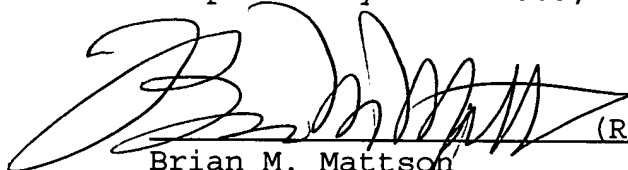
As to the rejection of Claim 12 under 35 U.S.C. §103(a) as being unpatentable over *Iliff* and *Schlueter et al.*, and further in view of *Siegrist, Jr. et al.*, Applicant respectfully submits that the rejection of Claim 12 is improper for the same reasons set forth with respect to Claim 1. Namely, none of *Iliff*, *Schlueter et al.* or *Siegrist, Jr. et al.*, taken singly or in combination, teach or suggest the features defined in Claim 1 as set forth above. Notice to that effect is requested.

Claims 2-14 depend from Claim 1; and Claims 16-20 depend from Claim 15. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional steps and elements of Applicant's method and system, respectively.

In view of the foregoing remarks, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is in condition for allowance. In addition, Applicant petitions the Patent Office to extend the time

limit for responding to the Final Rejection for one month so that the time period is extended to August 10, 2003. Also enclosed herewith is a check in the amount of \$55.00, the requisite fee for requesting this one-month extension of time. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

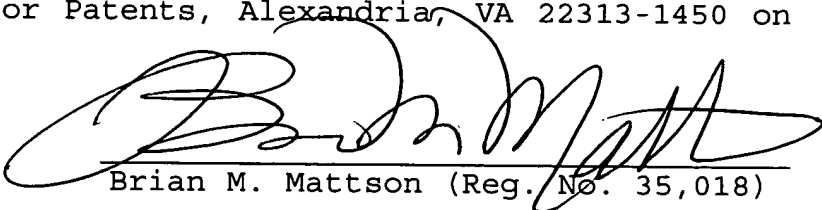


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CERTIFICATE OF MAILING

I hereby certify that this **RESPONSE TO FINAL REJECTION** and **check for \$55.00** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Mail Stop AF, Commissioner for Patents, Alexandria, VA 22313-1450 on August 11, 2003.



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